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11058 U.S. PTO

# UTILITY PATENT APPLICATION TRANSMITTAL (Small Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
39868/24659

Total Pages in this Submission

TO THE ASSISTANT COMMISSIONER FOR PATENTSBox Patent Application  
Washington, D.C. 20231

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

SHAPEABLE CATHETER

and invented by:

Larry D. Paskar

JC978 U.S. PTO

09/931562

08/16/01

If a CONTINUATION APPLICATION, check appropriate box and supply the requisite information:

☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 08/764,745

Which is a:

☐ Continuation ☐ Divisional ☒ Continuation-in-part (CIP) of prior application No.: 07/834,007

Which is a:

☐ Continuation ☐ Divisional ☒ Continuation-in-part (CIP) of prior application No.: 07/730,120

Enclosed are:

**Application Elements**

1. ☒ Filing fee as calculated and transmitted as described below
2. ☒ Specification having 41 pages and including the following:
  - a. ☒ Descriptive Title of the Invention
  - b. ☒ Cross References to Related Applications (if applicable)
  - c. ☒ Statement Regarding Federally-sponsored Research/Development (if applicable)
  - d. ☒ Reference to Microfiche Appendix (if applicable)
  - e. ☒ Background of the Invention
  - f. ☒ Brief Summary of the Invention
  - g. ☒ Brief Description of the Drawings (if drawings filed)
  - h. ☒ Detailed Description
  - i. ☒ Claim(s) as Classified Below
  - j. ☒ Abstract of the Disclosure

**UTILITY PATENT APPLICATION TRANSMITTAL**  
**(Small Entity)**

*(Only for new nonprovisional applications under 37 CFR 1.53(b))*

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**Application Elements (Continued)**

3. ☒ Drawing(s) *(when necessary as prescribed by 35 USC 113)*  
a. ☒ Formal      b. ☐ Informal      Number of Sheets 10
4. ☒ Oath or Declaration  
a. ☒ Newly executed *(original or copy)*      ☐ Unexecuted  
b. ☐ Copy from a prior application (37 CFR 1.63(d)) *(for continuation/divisional application only)*  
c. ☒ With Power of Attorney      ☐ Without Power of Attorney  
d. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s) named in the prior application,  
see 37 C.F.R. 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference *(usable if Box 4b is checked)*  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied  
under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby  
incorporated by reference therein.
6. ☐ Computer Program in Microfiche
7. ☐ Genetic Sequence Submission *(if applicable, all must be included)*  
a. ☐ Paper Copy  
b. ☐ Computer Readable Copy  
c. ☐ Statement Verifying Identical Paper and Computer Readable Copy

**Accompanying Application Parts**

8. ☐ Assignment Papers *(cover sheet & documents)*
9. ☐ 37 CFR 3.73(b) Statement *(when there is an assignee)*
10. ☐ English Translation Document *(if applicable)*
11. ☐ Information Disclosure Statement/PTO-1449      ☐ Copies of IDS Citations
12. ☐ Preliminary Amendment
13. ☒ Acknowledgment postcard
14. ☒ Certificate of Mailing  
☐ First Class      ☒ Express Mail *(Specify Label No.):* EL474183899US

**UTILITY PATENT APPLICATION TRANSMITTAL**  
**(Small Entity)**

*(Only for new nonprovisional applications under 37 CFR 1.53(b))*

Docket No.  
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**Accompanying Application Parts (Continued)**

15. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
16. ☐ Small Entity Statement(s) - Specify Number of Statements Submitted: \_\_\_\_\_
17. ☒ Additional Enclosures *(please identify below)*:

*Letter with attached Declaration and exhibits.*

**Request That Application Not Be Published Pursuant To 35 U.S.C. 122(b)(2)**

18. ☐ Pursuant to 35 U.S.C. 122(b)(2), Applicant hereby requests that this patent application not be published pursuant to 35 U.S.C. 122(b)(1). Applicant hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing of the application.

**Warning**

***An applicant who makes a request not to publish, but who subsequently files in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), must notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.***

**UTILITY PATENT APPLICATION TRANSMITTAL**  
**(Small Entity)**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
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**Fee Calculation and Transmittal**

**CLAIMS AS FILED**

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	67	- 20 =	47	x \$9.00	\$423.00
Indep. Claims	22	- 3 =	19	x \$40.00	\$760.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$355.00
OTHER FEE (specify purpose) _____					\$0.00
TOTAL FILING FEE					\$1,538.00

- ☐ A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge and credit Deposit Account No. 20-0823 as described below. A duplicate copy of this sheet is enclosed.
- ☒ Charge the amount of \$1,538.00 as filing fee.
  - ☒ Credit any overpayment.
  - ☒ Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
  - ☐ Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance, pursuant to 37 C.F.R. 1.311(b).

Dated:



21888

PATENT TRADEMARK OFFICE

*Gregory E. Upchurch*  
Signature

Gregory E. Upchurch, Esq., Reg. No. 28,482  
Thompson Coburn LLP  
One Firststar Plaza, Suite 3500  
St. Louis, MO 63101  
Ph: 314-552-6580  
Fax: 314-552-7580

Customer No. 021888

CC:

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: L. Paskar

GROUP ART UNIT: 3734

SERIAL NO.: 08/764,745

EXAMINER: M. Bockelman

FILED: 12/12/96

DOCKET NO.: 6490

FOR: Catheter

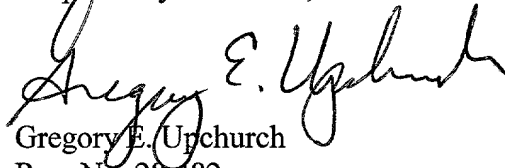
Assistant Commissioner for Patents  
Attn: Clerk of the Board of Patent  
Appeals and Interferences  
Washington, D.C. 20231

**EXPRESS ABANDONMENT UNDER 37 CFR 1.138  
OF APPLICATION ON APPEAL**

I request that the above-identified application, currently on appeal to the Board, be  
expressly abandoned as of the filing date accorded the continuing applications filed herewith.

I am attorney or agent of record acting under 37 CFR 1.34(a).

Respectfully submitted,



Gregory E. Upchurch  
Reg. No. 28,482  
Thompson Coburn LLP  
One Firststar Plaza  
St. Louis, Missouri 63101  
314/552-6580

0991562-081604

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**Applicant(s): **Larry D. Paskar**

Docket No.

**39868/24659**Serial No.  
To be assignedFiling Date  
**8/16/01**Examiner  
To be assignedGroup Art Unit  
To be assignedInvention: **SHAPEABLE CATHETER**

I hereby certify that the following correspondence:

**Letter to US PTO With Declaration of James F. Benenati, M.D. and Exhibit 1, Utility Patent Application Transmittal, Patent Application With Exhibits A-R and Formal Drawings (10 pages), Declaration and Power of Attorney, Postcard***(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231

8/16/01*(Date)*Gregory E. Upchurch*(Typed or Printed Name of Person Mailing Correspondence)*Gregory E. Upchurch*(Signature of Person Mailing Correspondence)***EL474183899US***("Express Mail" Mailing Label Number)***Note: Each paper must have its own certificate of mailing.**

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**Applicant(s): **Larry D. Paskar**

Docket No.

**39868/15410**

Serial No.

**08/764,745**

Filing Date

**12/12/96**

Examiner

**M. Bockelman**

Group Art Unit

**6490**Invention: **CATHETER**

I hereby certify that the following correspondence:

**Express Abandonment Under 37 CFR 1.138 Of Application On Appeal***(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231

8/16/01*(Date)*Gregory E. Upchurch*(Typed or Printed Name of Person Mailing Correspondence)*Gregory E. Upchurch*(Signature of Person Mailing Correspondence)*EL474183899US*("Express Mail" Mailing Label Number)***Note: Each paper must have its own certificate of mailing.**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Examiner: N/Y/A  
: )  
Larry D. Paskar ) Group Art Unit: N/Y/A  
: )  
: )  
Application No.: )  
Continuation of co-pending )  
Application No. 08/910,411 )  
: )  
Filed: August 13, 1997 )  
: )  
For: Shapeable Catheter )  
:

Assistant Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**LETTER**

Dear Sirs:

This correspondence is submitted to provide background to the present newly filed Continuation Application and to provide a discussion for the attached declaration.

Parent Application Status

The present application is a continuation of co-pending U.S. application no. 08/764,745 which is a file wrapper continuation of application no. 08/159,826 which is a continuation in part of the then co-pending application no. 07/834,007, filed on February 11, 1992, which has since issued as U.S. Patent No. 5,304,131; which is a continuation in part of the then co-pending parent



application no. 07/730,120, filed July 15, 1991, which has since issued as U.S. Patent Number 5,290,229 (hereinafter, "the '229 Patent").

The immediate parent application no. 08/764,745 is under final rejection and is currently before the Board of Patent Appeals and Interferences, which appeal is being dropped in favor of this and two other applications.

Applicant requests the opportunity to meet with the Examiner to illustrate models and a video that were sent to the Examiner in connection with the immediate parent application, to further explain the differences between the present claims and the prior art.

Present Continuation Application

The present continuation application has 32 claims of which claims 1, 4, 7, 10, 13, 16, 19, 23, 27 and 30 are independent.

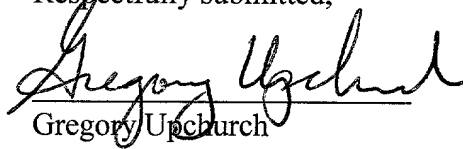
The specification of the continuation application differs from the specification of the '745 application (the immediate parent to this continuation) only by the inclusion of a more extensively detailed discussion of the inherent use of fluoroscopic imaging. This more detailed discussion is disclosed in the '745 application as well as the '229 patent. This more extensive discussion is included because it was already well known to those of skill in the art at the time of the filing of the '229 patent's application on July 15, 1991, that fluoroscopy was inherently known to those of skill in the art for the disclosed procedures. No new matter has been added to the disclosure and the claims of this continuation application are fully supported by the disclosures of the '229 patent and the '745 application.

Additional support for this position is provided in the attached declaration from Dr. James F. Benenati, an expert well qualified to judge the knowledge of "one of skill in the art" in the field of the present invention. Dr. Benenati's declaration provides context and support for the position that the procedures at issue are understood to inherently include the use of fluoroscopy. The knowledge of those skilled in the art concerning the shaping of catheters under imaging such as fluoroscopy is also shown in the articles attached hereto as Exhibits A-R.

Applicant respectfully submits that the present continuation application is patentable, and requests favorable consideration.

Applicants' undersigned attorney may be reached at (314) 552-6580. All correspondence should continue to be directed to the below listed address.

Respectfully submitted,



Gregory Upchurch  
Registration No. 28,482  
Thompson Coburn LLP  
Intellectual Property Group  
One Firststar Plaza  
St. Louis, MO 63101